

REMARKS

The Final Office Action of August 12, 2005, and the Advisory Action of September 12, 2005, have been considered by the Applicants. Claims 1, 10, 11, 14, 16, 20, 21, 23, 24, 26-31, and 33-37 have been amended. Claims 1, 3-11, 14, 16, and 18-40 are pending. Reconsideration of the Application is requested.

Claims 1, 3-7, 10, 12-14, 16, 20, 21, 23, 26, 28-30, 36, 37, 39, and 40 were rejected under 35 U.S.C. 102(b) as anticipated by Kasuya, U.S. Patent No. 5,480,759. Applicants traverse the rejection.

In the prior amendment of July 11, 2005, Applicants argued that claim 1 was not anticipated because it required the fluoropolymer to be homogeneously dispersed throughout the binder, whereas the Examiner was combining Kasuya's charge transport layer (which did not contain the fluoropolymer) with Kasuya's protective layer (which did contain the fluoropolymer) to meet the instant claim limitations. The Examiner responded by saying the instant claims did not require homogeneous dispersion.

Applicants have amended claim 1 to recite that the fluoropolymer must be homogeneously dispersed throughout the binder. In the Advisory Action, the Examiner stated that the specification as filed does not disclose the fluoropolymer as being homogeneously dispersed in the binder resin. Applicants disagree with this statement.

While Applicants concede the exact term "homogeneous" is not present in the disclosure, this limitation does not constitute new matter because the subject matter is inherently disclosed in the original specification. First, nowhere is a gradient discussed as might be expected if this aspect were important or required. Second, in Example II at page 23, ll. 10-19, the charge transport layer is described as being formed from a solution. Webster's II New College Dictionary, ISBN 0-395-96214-5, defines a solution as a "homogeneous mixture of two or more substances." This aspect of homogeneous dispersion is thus clearly contemplated by the Applicants and described in the specification. The specification clearly allows a person of ordinary skill in the art to recognize that Applicants invented what is claimed and that Applicants were in possession of the subject matter as now claimed. See MPEP § 2163.02. Please note that the subject matter of the claim need not be literally described in order for the

disclosure to satisfy the written description requirement. See MPEP § 2163.02. Applicants therefore believe this limitation has been disclosed in the specification. In order to expedite prosecution, Applicants also expressly disclaim any subject matter with regard to claim 1 and its dependent claims wherein the fluoropolymer is not homogeneously dispersed in the binder resin. This disclaimer does not apply to the subject matter of claims 19 and 22 and their dependent claims.

For these reasons, Applicants request withdrawal of the 102(b) rejections based on Kasuya.

Claims 8, 9, 11, 18, 22, 24, 25, 27, 28, 31-35, and 38 were rejected under 35 U.S.C. 103(a) as obvious over Kasuya in view of various handbooks. Applicants traverse the rejections.

The Examiner maintained the rejection for the same reasons as discussed in the 102(b) rejection. However, Applicants note that separate responses were provided for claims 18 and 22 in the prior amendment of July 11, 2005. Additionally, claim 22 was not rejected under 102(b).

Claims 8, 9, 18, and 38 all depend from independent claim 1. Because of the amendment of claim 1, a *prima facie* case of obviousness has not been made. Claims 11, 22, 24, 25, 27, 28, and 31-35 have been amended to depend from claim 19, which is non-obvious. Any claims depending from a non-obvious claim are themselves non-obvious. MPEP § 2143.03; *In re Fine*.

With regards to claim 18 and 22, Kasuya teaches perfluoroalkyl acrylates with the formula $-\text{CH}_2-\text{CH}_2-(\text{CF}_2)_n-\text{CF}_3$, where n is an integer of 4-16. Kasuya's perfluoroalkyl chain therefore requires a minimum of seven carbon atoms and no substitutes on C2. The fluoroalkyl (methyl)acrylates listed in claim 18 and 22 either have less than seven carbon atoms or have substitutes on C2. Kasuya would therefore not render claims 18 or 22 obvious. Please note that claim 22 is an independent claim.

For these reasons, Applicants request withdrawal of the 103(a) rejections based on Kasuya.

Applicants acknowledge the Examiner's statement that Claim 19 would be allowable if rewritten in independent form. However, claim 19 is already in independent form and has been so since the amendment of February 22, 2005. Claim 19 originally depended from claim 2, which originally depended from claim 1. The only difference noted between original claim 19 and current claim 19 is that original claim 19 additionally recited a substrate and a charge transport component. Because the novelty and non-obviousness of claim 19 are not dependent on these two components, Applicants do not believe their recitation is necessary. Applicants would appreciate either (1) a statement that claim 19 is allowable in its current state or (2) a statement as to what changes are necessary to put claim 19 in condition for allowance.

In addition, Applicants believe claim 22 should be allowable. Applicants note that in the amendment of July 11, 2005, the same arguments were made for claims 19 and 22. Claim 22 recites the same limitations as claim 19 and should be allowable at least on the same basis as claim 19. Also, please note that claim 22 has also been an independent claim since the amendment of February 22, 2005.

Claims 10, 11, 14, 16, 20, 21, and 23-37 have been amended to depend from claim 19. Support for these amendments can be found throughout the specification. These claims should therefore be allowable as well. In the Advisory Action, the Examiner stated that these proposed dependencies would require further search and consideration. Applicants believe further search is unnecessary because claim 19 has already been found allowable. As noted above, any claims depending from a novel, non-obvious claim are themselves novel and non-obvious. MPEP § 2143.03.

CONCLUSION

For the above reasons, all pending claims (1, 3-11, 14, 16, and 18-40) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,
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